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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,112	11/07/2001	Tony Williams	053134-0001	3398

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EXAMINER

LE, UYEN T

ART UNIT PAPER NUMBER

2163

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/036,112	Applicant(s) WILLIAMS ET AL.	
	Examiner Uyen T. Le	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 17-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7 February 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of group I (claims 1-16) in the reply filed on 23 August 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the group category table, unique part identifier table, part category table, the OEM number table, status field table, indicator table must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-9, 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as

opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, although the preamble of claim 1 recites a “graphical user interface”, the body of the claim merely recites pure descriptive material or at best a process that can be implemented by the mind of a person or by the use of a pencil and paper. Note that the limitation of “a user can access information from the tabular database” is purely descriptive and does not require a user to access any information. Note also that “wherein data for a prescribed part corresponding to the vehicle system/group category table, the vehicle part category table, and the unique vehicle part identifier table is displayed within the tabular display along a single row” does not require any interaction among those tables since data for a prescribed part is merely

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required to be "corresponding" to those tables. In other words, since the claimed invention, as a whole, does not apply, involve, use, advance the technological arts, nor produces a useful, concrete, and tangible result, thus it is deemed to be directed to non-statutory subject matter.

Claim Objections

5. Claim 8 is objected to under 37 CFR 1.75 as being a duplicate of claim 2.

Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed OEM number table, status field table, indicator table are not discussed in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention because it is not clear what the slash in "vehicle system/group category table" of claim 1 meant .

The art rejection of claims 1-16 is applied as best understood in light of the rejection under 35 U.S.C. 112, second paragraph discussed above and in anticipation of applicant amending the claims to overcome the rejection under 35 U.S.C. 101 discussed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1- 8, 10, 11, 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (US 5,317,503).

Regarding claim 1, Inoue discloses a graphical user interface including a tabular display and tabular database as claimed (see the abstract, Figures 2, 26). The claimed vehicle system/group category table is met by the list of car models. The claimed vehicle part category table is met by the list of names of parts. The claimed unique vehicle part identifier table is met by the list of parts numbers. Those tables are clearly linked as claimed since different car models have different parts and parts numbers. Furthermore, Figure 26 clearly shows that data for a prescribed part is displayed within the tabular display along a single row as claimed.

Regarding claims 2-8, the claimed tables have to be present for the graphical user interface of Inoue to retrieve correct replacement parts because each car model requires specific compatible parts.

Regarding claims 10, Inoue discloses the tabular database is located in the user's computer (see Figure 1).

Regarding claim 11, Inoue discloses the tabular database is stored in a CD-ROM for use in the user's computer (see Figure 1).

Regarding claim 14, Inoue discloses a vehicle pictorial display that displays the vehicle relating to the tabular database (see Figure 6).

Regarding claim 15, the graphical user interface of Inoue has to have a vehicle selection portion that selects the vehicle being displayed in the vehicle display for displaying the vehicle shown in Figure 6.

Regarding claim 16, the contents of the tabular database in the graphical user interface of Inoue have to change accordingly as a user selects a different vehicle as claimed since each vehicle has different specifications.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 9, 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (US 5,317,503), further in view of Larson et al (US 6,556,904).

Regarding claim 9, Inoue discloses all the claimed subject matter except that Inoue does not specifically show a billboard portion wherein a user can access a web site of the producer of the part. However, it is well known in the art as shown by Larson to provide such a portion for users to access related information over the Internet (see Figure 2). Furthermore, Larson specifically shows that the information provided over the Internet is vehicle specification data sets (see Figure 3). Therefore, it would have been obvious to one of ordinary skill in the art to include a web site of the producer of the part while implementing the graphical user interface of Inoue in order to connect the user to the part manufacturer for an integrated automotive diagnostic and service system as taught by Larson (see column 4, lines 29-35).

Regarding claim 12, 13, Inoue discloses all the claimed subject matter except that Inoue does not specifically show the tabular database is located in the Internet to which the user's computer is connected. However, Larson shows that it is well known in

the art to do so (see the abstract). Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed features while implementing the graphical user interface of Inoue in order to provide an integrated automotive diagnostic and service system for instantaneous access by service and repair technicians as taught by Larson (see column 2, lines 30-36, column 4, lines 29-35).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Williams et al (US 2002/0198794) teach an inventory management system for determining suggested part stocking levels for a vehicle dealer.

Schreitmueller et al (US 6,185,540) teach an insurance estimating system.

Lucas et al (US 2001/0034656) teach on-line commerce for the supply of parts.

Hancock et al (US 2003/0009361) teach interfacing with a shipping service.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 571-272-4021. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2 February 2005



UYEN LE
PRIMARY EXAMINER